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Confirm. No. : 4486
Appl. No. : 09/441,535
Applicants : Karl Klaghofer et al.
Filed : November 16, 1999
Art Unit : 2665
Examiner : Steven H.D. Nguyen
Title : Multimedia Terminal for Telephony Allowing
Multipoint Connections
Docket No. : GR 98 P 5938
Customer No. : 24131

RESPONSE

Mail Stop No-Fee Response
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner Nguyen:

The following remarks respond to the Office action dated February 24, 2004. Reconsideration of the application is requested. Claims 1-4 remain in the application.

In item 3 of the Office action, the Examiner rejected claims 1-4 as being obvious over Hamdi (U.S. 6,205,124) in view of Kumar (U.S. 6,163,531) under 35 U.S.C. § 103(a). As will be

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explained below, the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Claim 1 calls for, *inter alia*, a multimedia terminal for telephony based on ITU-T Standard H.323 for setting up a multipoint connection to a plurality of terminals. The multimedia terminal includes the following features:

a controller for processing signaling information for a point-to-multipoint connection between the multimedia terminal and a plurality of terminals; and

a mixer, connected to said controller, for mixing datastreams originating at the multimedia terminal and at the plurality of terminals and for providing datastream mixtures to the plurality of terminals.

Hamdi discloses a conferencing system that is connected to an analog telephone network (POTS 181) via a first and a second modem in order to communicate with a first and a second remote modem via this telephone network. So-called DSVD modems (digital simultaneous voice and data) are used as modems, by means of which, voice and data can be transmitted in parallel via an analog telephone line. For this purpose, the data and voice are converted into analog signals within the transmission bandwidth of the POTS by the DSVD modem. Thus,

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the essential aspect in Hamdi is to be seen in realizing a conferencing circuit, where, in addition to voice, data are also to be transmitted - via an analog telephone network.

In contrast, Kumar describes a conference system based completely on a digital protocol, ITU-T standard H.323.

The objects disclosed in Hamdi do not offer any incentive that would have given one with ordinary skill in the art reason to combine Kumar with Hamdi in a manner as chosen by the Examiner. The motivation "to provide a subscriber a multipoint conference system without subscribing to a service provider" indicated by the Examiner would not explain why one with ordinary skill in the art would choose Kumar and combine

it with Hamdi. Whether a subscriber must use a service provider does not depend on whether an analog or digital transmission network is used, but rather depends on whether the subscribers are close enough to each other to be able to be connected via a private network or whether an external network of a service provider is necessary. Kumar also uses a service provider (see Kumar, Fig. 1, ISDN network 150), when remote subscribers are to be integrated into the conference. As is the case in Kumar, a public POTS is only necessary in Hamdi when remote subscribers are to be connected. In conferences via a private branch exchange, Hamdi also does not require a service provider. A consideration of Kumar thus

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would not have an influence on whether or not a service provider is necessary. The motivation indicated by the Examiner could thus also be satisfied without Kumar, in that a private (analog) network is used instead of the POTS.

With regard to the motivation indicated by the Examiner, Kumar is to be considered to actually teach away because Kumar claims a conference service centrally located in the network. This means that the advantage of a functionality, which is transferred to the terminal, which does not require access to a central conference service, is lost in Kumar. Otherwise, neither Hamdi nor Kumar contains information as to why Kumar should only carry out the conversion to H.323, but not the central conference device, which is provided according to
H.323.

Furthermore, contrary to the Examiner's statement, Hamdi does not propose to configure a telephone conference according to an ITU standard. Instead, ITU standards are mentioned in Hamdi exclusively in context with types of modulation that allow for a parallel transmission of voice and data via a voice frequency band. Only the ITU-T-recommendation V.70 is explicitly indicated, which pertains to the above-mentioned DSVD technology (digital simultaneous voice and data). See col. 1, lines 49-66. This ITU standard has nothing to do with

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configuring teleconferences, but pertains to a DSVD on-off operations (see, for example, col. 2, lines 20-23 in Hamdi).

The mere mentioning of the ITU-T-V.70 standard in Hamdi does not suggest the use of the H.323 standard, which differs therefrom, because the V.70 standard pertains to a completely different technical problem than the H.323 standard on which the invention is based. Furthermore, the combination of the H.323 standard and not one of several hundred other ITU standards, with Hamdi seems arbitrary and, therefore, motivated by hindsight.

In summary, no motivation existed in the prior art that would have prompted a person one with ordinary skill in the art to combine Kumar with Hamdi in the manner chosen by the Examiner. Such a combination of features of different documents that were chosen afterwards by the Examiner with the knowledge of the invention in order to cover the features of claim 1, corresponds to an inadmissible piecemeal hindsight consideration.

We note, with reference to Fig. 1 of Hamdi, that it does not - as indicated by the Examiner - illustrate the conferencing system itself, but a, "Computer system supporting the multipoint digital simultaneous voice and data system." See, for example, col. 3, lines 6-8. The conferencing system is

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only illustrated in Figs. 2B and 3. However, it cannot clearly be seen which parts of the computer system or the conferencing system can be interpreted as terminal according to claims 1 and 3, and whether a controller as well as a mixer according to claims 1 and 3 are present in this terminal.

Accordingly, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Therefore, claim 1 is patentable over the art. Moreover, because all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-4 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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